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Docket No. PRECI-P5366

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCE

In re Application of: Walter W. Mosher, Jr., Michael L. Beigel,
and Thomas P. Mahoney

Serial No.: 09/033,832

Art Unit: 3628

Filed: March 3, 1998

Examiner: B. Green

For: IDENTIFICATION DEVICE HAVING REUSABLE
TRANSPONDER

TO 3660 MAIL ROOM

SEP 27 2000

RECEIVED

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

REPLY BRIEF OF APPELLANT TO EXAMINER'S ANSWER

Sir:

This brief is responsive to the examiner's answer filed July 26, 2000.

SUMMARY OF THE INVENTION

Applicant's invention relates to a radio frequency device 10 which includes disposable attachment means 12 for locating it on an object or an individual to be identified. The attachment means may be a disposable wristband having opposite extremities (Application page 6, lines 3-10).

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Thomas P. Mahoney, Reg. No. 15,513

September 22, 2000

DATE

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Reusable securement means 14 is demountably engaged with the opposite extremities of the wristband 10 to maintain it in temporary relationship with a person or object. The reusable securement means 14 is in a temporary operative relationship with the extremities of the wristband and is separable from the wristband when the wristband is discarded (page 6, lines 14-18). A radio frequency identification circuit 30 is embedded in the securement means for reuse with the securement means 14 on a replacement wristband after the disposable wristband has been discarded (page 7, lines 4-6). The wristband 10 can be utilized in such environments as hospitals wherein the wristband is attached to the wrist of the patient. The radio frequency identification circuit 30 is responsive to a reader which can read information in the circuit from a distance, thus ensuring that a patient will be properly identified. The circuit can also provide additional information such as medication, conditions to be treated, and the like.

CLAIM REJECTION UNDER 35 USC §112

Claim 20 has been rejected on 35 USC §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because, in lines 2-3 of claim 20, there is no antecedent basis for "said circuit means."

The *Manual of Patent Examining Procedures*, paragraph 706.03(b), examiner note 1, states: "This paragraph is to be used only where applicant has stated, somewhere other than in the application, as filed, that the invention is something different from what is defined in the claims."

It is respectfully submitted that, no such statement has been made by applicant and that the use of the word "circuit" in claim 20 adequately relates to the word "circuit" in claim 19.

CLAIM REJECTION UNDER 35 USC 102(b)

Claim 25 has been rejected under 35 USC 102(b) as being anticipated by Hayes (U.S. Patent No. 4,718,374).

Claim 25 is a sub-combination claim calling for reusable securement means having a body with securement portions thereupon which are demountably engagable with opposite extremities of disposable attachment means to maintain the attachment means on an object or individual, said body having radio frequency identification circuit means embedded therein. The examiner's statement that Hayes shows a reusable securement means is totally contrary to the teachings of Hayes.

Hayes does not show a reusable securement means. The securement portions of the securement body, as defined in claim 25, are demountably engagable with opposite extremities of disposable attachment means. The head portion 46 of Hayes '374 is not demountably engagable with opposite extremities of disposable attachment means. Claim 25 further defines the body as having radio frequency identification circuit means embedded therein. There is no radio frequency circuit means embedded in the head portion 46 of Hayes.

It appears that the Examiner has deviated from the teachings of Hayes '374 in that Hayes shows a head portion 46 which is urged through a slot in the ear of an animal and a

retaining member 24 is then urged over the head portion until it snaps into place at the end of the head portion. Hayes describes this action at Col. 6, l. 55-60, as follows:

“Thus, head portion 46 may be forced through the slot by resilient, outward deflection of rib portions 58, 59 which then resiliently inwardly deflect to engage abutment ledge means 56, 57 whereby the head portion 46 may not be withdrawn through the slot after assembly on the animal ear.”

Hayes clearly states that “the head portion 46 may not be withdrawn through the slot after assembly on the animal ear.” The language clearly does not support the Examiner’s statement “a reusable securement means.” Furthermore, nowhere in Hayes is there any statement regarding reusable securement means having securement portions engagable with opposite extremities of disposable attachment means. In Hayes, the attachment means 24 and 46 are located at one end of the tag of Hayes.

REJECTIONS UNDER 35 USC §103(a)

Claims 19-25 and 27 are rejected under 35 USC §103(a) as unpatentable over de Jong (U.S. Patent No. 4,612,719), in view of Hayes (U.S. Patent No. 4,718,374).

The examiner holds that de Jong shows, in Figs. 8 and 9, a band (6), a securement means (1,90), and a responder (2). However, the teachings and language of de Jong do not conform to the examiner’s statement describing Figs. 8 and 9 which show a “synthetic plastic holder 1, wherein a detection element 2 diagrammatically shown is embedded.” (Col. 2, lines 55-57).

Fig. 8 shows a wedge 80 for engagement with a band 6 to hold the holder 1 on an animal. Fig. 9 shows three ribs, 90, 91, and 92 integral with the holder and designed as shear pins.

The wedge 80 and ribs 90, 91, and 92 are securement means for the band 6, but the detection element 2 is not located in the securement means but in the holder 1. Furthermore, there is no teaching of temporary connection of the holder 1 to the securement means on the holder which form substantially permanent portions of the holder.

In order to create a relevant and meaningful basis of rejection, the examiner proceeds to reconstruct the teachings of de Jong by stating, page 4, "The responder (2) is considered to be embedded in the securement means." However, it can be readily seen that de Jong teaches the responder 2 as being located in the holder 1. Adding the negative and mutilated teachings of Hayes to de Jong to create a basis for an obviousness rejection accomplishes nothing.

Claims 19-25 have been rejected under 35 USC 103(a) as unpatentable over Pennock, et al (U.S. Patent No. 5,140,946) in view of Hayes (U.S. Patent No. 4,718,374).

The examiner holds that Pennock, et al shows, in Figs. 1-2, a band (40) and a securement means (10) but admits that Pennock, et al does not disclose placing a radio frequency circuit means within the securement means.

The examiner then turns to Hayes which does not show a reusable securement means within the disclosure of the application, nor does he show a securement means

which is temporarily associated with the body 22. As a matter of fact, Hayes teaches permanent affixation of the body 22 to the ear of an animal and there is absolutely no teaching of a securement means having a body in which an RFID is located and which is temporarily associated with the attachment means.

RESPONSE TO EXAMINER'S ARGUMENT

There is not a scintilla of disclosure in any of the three applied patents, namely, Hayes '374, de Jong '719, and Pennock '946 of a reusable securement means incorporating an RFID which is temporarily associated with a disposable attachment means to maintain the RFID in temporary association with the disposable attachment means.

In order to apply the teachings of Hayes '374, the examiner has resorted to an argument regarding the meaning of the term "reusable." Applicants, despite their belief that the meaning of the term is amply supported in the specification and claims of the application, have amended the specification on page 1, line 23 to read "The terms 'reuse' and 'reusable' in the context of this disclosure apply to the removal and reuse of the securement means and the embedded circuit in the securement means." Nowhere, in any of the prior art, is there any teaching of such a securement means with an embedded RFID circuit removably associated with a disposable attachment means.

The examiner's argument that, in Hayes, the head portion (46) may be applied or modified in various ways to meet the terms of the claims and disclosures of the

specification are without support in the light of Hayes's declaration that the head portion (46) which serves as a securement means may not be withdrawn from the animal's ear.

In discussing the rejection of claim 25, the examiner misreads the claim and states that there is no need for the circuit means to be embedded in the head portion 46 of Hayes because, in claim 25, the circuit means is embedded in the body. The examiner ignores the limitation that the body referred to is the body of the securement means.

In order to support the rejection, the examiner also states that, in order to reuse the body (22) of Hayes, the attachment (24) would be broken. This would allow the body to be separated from the attachment. Certainly, such mutilation of the teachings of Hayes cannot be utilized to create an obviousness rejection based on the combination of de Jong and Hayes.

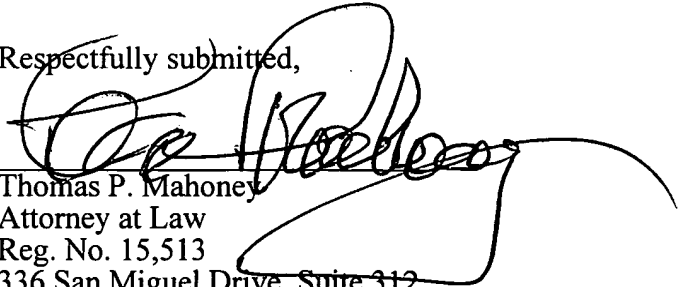
CONCLUSION

Applicants respectfully submit this reply and request a reversal of the examiner's rejections.

Date:

9/22/00

Respectfully submitted,


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Enclosures